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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,978	01/03/2001	Wayne R. Lumpkin	AVID.13-3	1708

25871 7590 04/02/2003

SWANSON & BRATSCHUN L.L.C.
1745 SHEA CENTER DRIVE
SUITE 330
HIGHLANDS RANCH, CO 80129

EXAMINER

KIM, CHONG HWA

ART UNIT

PAPER NUMBER

3682

DATE MAILED: 04/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



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DATE MAILED: 10/08/2002

#18

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Office Action Summary

Applicati n N .

09/753,978

Applicant(s)

LUMPKIN, WAYNE R.

Examin r

Chong H. Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5,6 and 8-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,6 and 8-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6 and 7. 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I – Figs. 1-3A in Paper No. 15 is acknowledged. The traversal is on the ground(s) that the Examiner failed to show both that the process as claimed is not an obvious process of making the product and that the process as claimed can be used to make other and different products. This is not found persuasive because showing that the process as claimed is not an obvious process of making the product is not required since the applicant already claims such process as being patentably distinct. Claiming such process is in fact admitting that such process is not an obvious process of making the product. Furthermore, the matter of the process as claimed being used to make a fiber optic cable system being flawed, it is the examiner's position that one of the method used to make a fiber optic cable system is to provide a straight length of rigid tubing; feeding the flexible cable through the rigid tubing; and fixing one end of the rigid tubing against axial movement. Moreover, Examiner believes that the search and examination of the inventions and distinct species as claimed can place serious burden on the Examiner.

The requirement is still deemed proper and is therefore made FINAL.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the second length of flexible housing and the second ferrule joining the second flexible housing to the second end of the rigid tubing as

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recited in claims 6 and 9 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites the limitation "the first end of the housing" in line 3. There is insufficient antecedent basis for this limitation in the claim.

- Claim 10 recites the limitation "the axially rigid and radially flexible housing" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who

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has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by Matsuo, U.S. Patent 6,349,614 B1.

Matsuo shows, in Figs. 1-12, a bicycle cable guide system for maintaining tension in a straight portion of a flexible cable extending between a cable actuated bicycle component and a cable actuator selectively applying tension to the flexible cable, the cable guide system comprising;

a straight length of axially and radially rigid tubing 654 having first and second ends and an inner diameter greater than an outer diameter of the flexible cable 650 receiving the straight portion of flexible cable;

a first axially fixed connector (as shown in Fig. 12) operatively associated with the first end of the rigid tubing;

a second axially fixed connector (as shown in Fig. 10) operatively associated with the second end of the rigid tubing; and

wherein the first axially fixed connector comprises a first length of flexible housing 674 receiving the flexible cable and a ferrule 630 between the first end of the housing and the first length of flexible housing.

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7. Claims 5 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Matsuo, U.S. Patent 6,349,614 B1.

Matsuo shows, in Figs. 1-12, a bicycle cable guide system for maintaining tension in a straight portion of a flexible cable extending between a cable actuated bicycle component and a cable actuator selectively applying tension to the flexible cable, the cable guide system comprising;

a first length of flexible housing 674 having a select outer diameter and an inner diameter greater than the diameter of the cable 650;

a straight length of axially and radially rigid tubing 654 having an inner diameter greater than the diameter of the flexible cable;

a ferrule 630 joining an end of the first length of flexible housing to a first end of the axially and radially rigid tubing (as shown in Fig. 12); and

wherein the axially and radially rigid tubing has an outer diameter substantially the same as the outer diameter of the axially rigid and radially flexible housing.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 6, 8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsuo.

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Matsuo shows, as discussed above in the rejection of claim 5, the bicycle cable guide system comprising the first length of flexible housing and the first ferrule connecting the flexible housing and the one end of the rigid tubing; wherein the flexible housing has an axial length that does not radially buckle under application of tension to the flexible cable under a normal range of operating tensions applied to the cable to actuate the cable actuated component, but fails to show a second length of flexible housing and a second ferrule joining the flexible housing to the second end of the rigid tubing; and the cable actuated bicycle component being a cable actuated disc brake caliper.

It would have been obvious to make the second length of flexible housing and a second ferrule joining the flexible housing to the second end of the rigid tubing of Matsuo, since such a modification would have involved a mere duplication of components. The duplication of parts is generally recognized as being within the level of ordinary skill in the art. *In re Harza*, 124 USPQ 378.

As to the matter of the cable actuated bicycle component being a cable actuated disc brake caliper, it would have been obvious to apply the cable actuated device of Matsuo on the cable actuated disc brake caliper, since such a modification would have involved a mere application of present invention on an existing device. The selection of known device based on its suitability for the intended use is generally recognized as being within the level of ordinary skill in the art. *In re Leshin*, 125 USPQ 416. (Note: the Applicant is reminded to cancel claim 8 since the applicant's attorney had confirmed that no other parts of the present invention would be claimed except the cable guiding system.)

Double Patenting

10. Claims 1, 2, 5, 6, and 8-10 are rejected under the judicially created doctrine of double patenting over claims 1-8 of U. S. Patent No. 6,439,077 B2 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: the rigid tubing having two ends, connectors, two flexible housings, two ferrules joining the flexible housings to the ends of the rigid tubing.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bicycle cable guide system having connectors.

Kine, U.S. Patent 3,957,138

Sopko, U.S. Patent 4,031,343

Toyomoto, U.S. Patent 4,066,147

Yoshigai, U.S. Patent 4,823,918

Nagano, U.S. Patent 4,833,937

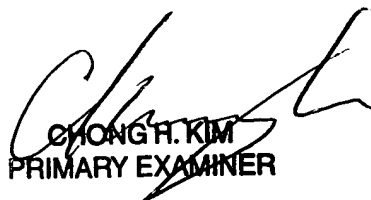
Art Unit: 3682

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chong H. Kim whose telephone number is (703) 305-0922. The examiner can normally be reached on Monday - Friday; 9:00 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Bucci can be reached on (703) 308-3668. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

CHK
October 3, 2002


CHONG H. KIM
PRIMARY EXAMINER